

REMARKS

Communication of September 8, 2003

Applicants initially filed on August 29, 2003, a Reply in response to the Office Action of May 29, 2003. Thereafter, the Office issued a Communication on September 8, 2003, advising the applicants that the prior Reply was noncompliant for failing to indicate the status of all claims. This Reply properly sets for the status of all claims. The following remarks are the same as presented in the August 29, 2003 Reply.

Amendments

Applicants gratefully acknowledge the Examiner's indication that claim 1 is allowed and that claims 9-11 are allowable.

Claim 8 is amended to delete exemplary language, to use language in accordance with conventional US practice, and to provide express definitions of variable groups. Claim 9 is also amended provide express definitions of variable groups. New claims 12-55 are directed to further aspects of applicants' invention. See, e.g., page 10, lines 23-27, page 44, line 21-page 45, line 6, and the compounds listed at pages 12-30.

Rejection of the Claims Under 35 U.S.C. §112, second paragraph

Claims 3, 8, and 9 are alleged to be indefinite pursuant to 35 USC §112, second paragraph. This rejection is respectfully traversed.

Claim 3 is alleged to be a substantial duplicate of claim 2. This is incorrect. Claim 2 recites phthalide compounds as well as 2,3-benzoxazin-1-ones. See, e.g., the second compound listed in claim 2. As for claims 8 and 9, as noted above, these claims have been amended to provide express definitions of variable groups. Further, claim 8 has been amended to delete phrases like "such as" and "for example."

In view of the above remarks, withdrawal of the rejection is respectfully requested.

Obviousness-type Double Patenting Rejection

Claims 2-6 are rejected on grounds of obviousness-type double patenting in view of “claims” of US 6,245,804 and US 6,344,454. This rejection is respectfully traversed.

First, it is noted that double patenting rejections can only be based on the claims of a US patent document. Yet, the present rejection does not state which claims of US ‘804 or US ‘454 are being relied on in the rejection.

All of the claims of US ‘804 recite phthalide compounds. See the definition of Ar in claim 1. Applicants’ claim 2 recites numerous specific compounds, but only about 12 are phthalide compounds. The rejection does not, however, explain how one of ordinary skill in the art looking at any of the claims of US ‘804 would be motivated to select one of these twelve compounds. Without such motivation, obviousness is not established.

Claim 1 of US ‘454 is directed to a broad genus of compounds wherein Ar is selected from various partial formula, one of which is a 2,3-benzoxazin-1-one structure. See partial formula 10. Of the remaining claims, only claim 12 specifies that Ar is a 2,3-benzoxazin-1-one structure. However, in this claim Ar is still broadly defined. Compare the definition of Ar in claim 1 of US ‘454 and the definition of Ar used in applicants’ claim 1 and in the compounds recited in claim 2. Claim 16 does list specific 2,3-benzoxazin-1-one compounds. Yet, the rejection does not describe how one of ordinary skill in the art would be motivated from the claims of US ‘454, including claims 12 and 16, to select a compound in accordance with the recitations of applicants’ claims 2-6. Without such motivation, obviousness is not established.

Withdrawal of the obviousness-type double patenting rejection is respectfully requested.

Rejection Under 35 USC §102 or §103

Claims 2-6 and 8 are rejected as being obvious in view of US '804 and US '454. This rejection is respectfully traversed.

The rejection presents no rationale as to how one of ordinary skill in the art would be motivated to select a compound in accordance with applicants' claim 2 based on the disclosure of a broad generic group of compounds. The rejection refers to a STN/CAS printout, but does indicate where any of the compounds of claim 2 are described therein. Nor does the rejection describe how one of ordinary skill in the art would be motivated to modify any of the specific compounds described in US '804 or US '454 so as to arrive at a compound according to applicants' claim 2. See, e.g., *In re Jones* and *In re Baird*.

As for claim 8, the rejection refers to the disclosure at columns 13-20, but does not describe how one of ordinary skill in the art would be motivated to select a process in accordance with applicants' claim 8

In view of the above remarks, withdrawal of the rejection is respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



Brian P. Heaney, Reg No. 32,542
Millen, White, Zelano & Branigan, P.C.
Courthouse Plaza I
2200 Clarendon Blvd., Suite 1400
Arlington, VA 22201
Direct Dial: (703) 812-5322
email: mccarthy@mwzb.com

Filed: September 16, 2003